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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,521	06/18/2001	Takaaki Amano	100809-16269 (SCET 18.757	2615
7590 05/03/2006 KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK,, NY 10022-2585			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/885,521

Applicant(s)

AMANO ET AL.

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/08/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 12 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding claims 12 and 13, these claims appear to be programming (or merely data) per se, which is not statutory. If the preamble set forth such computer executable instructions on a computer readable medium, then the claim would appear to be statutory. Please reference MPEP 2106 (IV) (B) (1) (a) for the basis of this rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie (U.S. Patent No. 6,014,634).** Scroggie teaches an advertisement forming system and method that includes all of the limitations recited in the above claims.

**Regarding claims 1, 2, and 12,** Scroggie teaches combining character information and image information to form an incentive image (banner advertisement) (Column 2, Lines 55-64). Acceptance and storage of the character and image information before combination is inherent.

**Regarding claim 3,** Scroggie teaches advertisement forming information as including arrangement relationship (coordinates), information related to a method of displaying (size), information related to an outer shape (border parameters) (Column 10, Lines 26-59), and a color (Column 11, Lines 17-30).

**Regarding claim 4,** Scroggie teaches accepting advertisement identification information used to identify the incentive (Column 6, Lines 14-17) and storing it (inherent).

**Regarding claims 5 and 6,** Scroggie teaches accepting an advertisement forming command (user log-in) and forming the advertisement upon receipt of that command (displaying offer to consumer) (Column 6, Lines 14-17).

**Regarding claims 7-9, 11, and 13,** Scroggie teaches a consumer registering with the system (user is prompted) by inputting personal information (which is stored) (Column 9, Lines 36-49), and relating that information to an advertisement by inputting that personal information (name) and attribute information (selection of supermarket consumer wishes to shop in) into the advertisement (Column 10, Lines 60-64).

**Regarding claim 10,** Scroggie teaches combining character information and image information to form an incentive image (banner advertisement) (Column 2, Lines 55-64). Acceptance and storage of the character and image information before

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combination is inherent. Scroggie also teaches accepting an advertisement forming command (user log-in) and forming the advertisement upon receipt of that command (displaying offer to consumer) (Column 6, Lines 14-17).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to banner forming systems and methods:

U.S. Patent No. 6,327,574 to Kramer

U.S. Patent No. 5,724,521 to Dedrick

U.S. Patent No. 5,948,061 to Merriman


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**